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WARD KRAFT, INC.
P.O. BOX 938
FORT SCOTT, KS 66701

EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,263

Applicant(s)

TUCKER, D. MARK

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, and 3-20 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/09/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

The drawings are objected to because of Figure 2 having the second section defined well below the first line of weakness unlike Figures 1 and 3. Also in Figure 2, the reverse printing that is shown in the drawing is not truly reverse printing but reverse spelling. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a first quadrate die cut in the pattern of adhesive and a second quadrate

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die cut inward of the first and existing only in the liner material as described in the specification. Furthermore, the drawings also do not show a liner material having at least first and second substantially quadrate die cuts along with a first quadrate die cut in the area occupied by adhesive and a second quadrate die cut inward of the first and existing only in the liner material as described in the specification.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 6, 8, 18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "full sized sheet" in claims 6, 8, 18, and 20 is a relative term which renders the claims indefinite. The term "full sized sheet" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, and 3 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. 6,989,183) in view of Kelly (U.S. 5,900,610).

Regarding Claim 1, McKillip discloses a two section substrate 12 with two faces able to receive indicia (Column 5, Lines 6 – 10; Figures 1 and 3, Item 12; Claim 1) with a pattern of adhesive 18 in one of the two sections (Column 5,

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Lines 11 – 13, Figure 13, Item 18). Also disclosed is a liner material 14, which can be glassine (Column 5, Lines 11 – 20), in the same section as the adhesive (Column 5, Lines 11 – 13, Figure 3, Item 14) along with a line of weakness 20 that separates the first and second section (Column 5, Lines 25 – 28; Figure 1, Item 20). McKillip also discloses quadrate die cutting to make lines of weakness 20 and labels 22 (Column 5, Lines 21 – 27). The quadrate die cut labels exist in the section occupied by adhesive (Figure 2, Item 20; Figure 3, Items 18, 20, and 22).

McKillip does not disclose a second substantially quadrate die cut inward of the first die cut and disposed only in the liner material covering the pattern of adhesive. Furthermore, McKillip does not disclose die cutting on different layers.

Kelly discloses a label with an outer quadrate die cut 58 and another quadrate die cut 60 inward of the previously mentioned die cut (Column 8, Lines 12 – 16; Figures 6 and 7, Items 58, and 60). Kelly also mentions that cut 58 is only done through the backing layer which is a release material and that cut 60 is only done through the substrate (Column 8, Lines 45 – 52; Figure 7, Items 58 and 52 [adhesive], 60). The difference with the application is that Kelly's cuts are switched to where 60 is the backing layer cut and 58 is the face cut. When Kelly's reversed label die cuts are incorporated to McKillip's release layer 14 the claimed invention is produced. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use McKillip's form and modify it by using Kelly's die cuts, on the opposite faces, and

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incorporating them in the second section of McKillip in order to create a form with multiple removable labels.

In regards to Claim 3, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The phrases “used as a shipping label and is used in connection with a box, package, container and combinations thereof “ do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, the business form label combination of Marchetti allows the user to use it as a shipping label and in connection with the previous mentioned combinations (Paragraph 0037, Lines 7-14; Figure 4B and 6B).

In regards to Claim 4, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The phrases “used as a time capsule device, secure records holder, document retention packet, MSDS envelope, technical data sheet carrier...” do

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not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, the business form label combination of Marchetti allows for any desired indicia to be printed on the first section and placed in the shipping envelope (Paragraph 0019, Lines 1-4). This can cover secure records, technical data, MSDS or any other combination.

In regards to Claim 5, as applied to Claim 1, McKillip discloses another line 20 that runs perpendicular to the first line of weakness through one of the first and second sections (Figure 1, Items 20 [between labels 22a and 22b]).

In regards to Claim 6, as applied to Claim 1, the first section of substrate 12, which is above line 20, is considered to be full sized sheet (Figure 1, Items 12 and 20) for receiving information (Column 5, Lines 6 – 10; Column 5, Lines 4 – 10) and the second section of substrate 12, which is below line 20, is shown not to be of equal dimensions to the first section (Figure 1, Items 12 and 20).

3. Claim 7 rejected under 35 U.S.C. 103(a) as applied to Claim 1 and in further view of Popat (U.S. 5,389,414). McKillip and Kelly do not disclose a sheet size of 8½ inches by 11 inches.

Popat's sheet 20 is disclosed to be 8½ inches by 11 inches (Column 2, Lines 59-60). Therefore it would have been obvious to one having ordinary skill

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in the art to incorporate Popat's sheet size as the sheet size for McKillip's first section of substrate 12 in order to increase the ease of use since the average home and office printer has a standard sheet size of 8½ inches by 11 inches and many times forms are printed on 8½ inch by 11 inch sheets. This alteration also increases the consumer market as well.

4. Claims 8 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. 6,989,183) in view of Kelly (U.S. 5,900,610).

In regards to Claim 8, McKillip discloses that one of the labels 22 can be used as a shipping label, therefore it is inherent that the label can be used on a carton's surface (Column 5, Lines 47 – 51). McKillip also discloses a substrate 12 (Column 5, Lines 6 – 10; Figures 1 and 3, Item 12) that is able to receive indicia and is separated into first and second sections by a line of weakness 20 that is created by a die press (Column 5, Lines 21 – 27; Column 5, Lines 25 – 28; Figure 1, Item 20). McKillip further discloses that labels 22 have indicia on one surface and adhesive 18 on the second surface (Figure 1, Items 22 and 18). In regards to the first section being a full sized sheet, it is disclosed that substrate 12 can be paper (Column 5, Lines 4 – 10) and is considered to be a full sized sheet, as shown in Figure 1, above line of weakness 20. Furthermore, McKillip discloses a quadrate die cut label 22 where the substrate acts as a release ply for the label (Column 5, Lines 21 – 27; Figure 2, Items 20, 22c).

McKillip does not disclose a containment envelope of any kind.

Kelly discloses a label with an outer quadrate die cut 58 and another quadrate die cut 60 inward of the previously mentioned die cut (Column 8, Lines

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12 – 16; Figures 6 and 7, Items 58, and 60). Kelly also mentions that cut 58 is only done through the backing layer which is a release material and die cut 60 is only through the substrate (Column 8, Lines 45 – 52, Figure 7, Items 58 and 60). When incorporated to McKillip's release liner 14 the claimed invention is produced. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Kelly's die cuts into the release liner of the second section of McKillip in order to create a business form with multiple removable labels.

In regards to Claim 9, as applied to Claim 8, please refer back to the Claim 8 rejection where the die cuts of Kelly are discussed.

In regards to Claim 10, as applied to Claim 8, please refer back to the Claim 8 rejection where the first line of weakness 20 is discussed.

5. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. 6,989,183) in view of Kelly (U.S. 5,900,610), as applied to Claim 8, and in further view of Smith (U.S. 5,330,232). McKillip and Kelly do not disclose that the containment envelope is provided with reverse printing on the rear surface.

Smith discloses a transparent film 20 with front 21 and rear 22 surfaces where the front receives no indicia and the rear receives reverse printed indicia 25 (Column 3, Lines 29 – 36). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Smith to McKillip modified by Kelly on the rear surface of substrate 12 in order to create a label with indicia that is protected by the front

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surface and will not be damaged when placed on a carton and rubbed by various objects.

6. Claims 11, and 14 – 16 are rejected under 35 U.S.C. 103(a), as applied to Claim 8, and in further view of Popat (U.S. 5,389,414). Popat teaches a vertical running perforated line 30 (Column 4, Lines 26 – 29; Figure 2) that perpendicularly intersects two perforated lines 32 and 42 (Column 3, Lines 25 – 33, Figure 2, Items 30, 32, 42). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Popat's vertically running perforated line 30 and horizontal perforated line 32 to McKillip's form and have line 30 intersect line 20 perpendicularly. This would create four equally sized compartments enabling different types of information to be printed. It also allows for the sheet to reduce by folding and allow for tearing without damaging any printed material.

In regards to Claim 15, Popat discloses line 32 being disposed substantially medially of the sheet (Column 4, Lines 26 – 29; Figure 2, Items 30, 32, and 42). This creates a more even and equal separation of the sheet and allows for information to be spread more evenly.

7. In regards to Claim 16, as applied to Claim 8, McKillip and Kelly do not disclose a sheet size of 8½ inches by 11 inches.

Popat discloses a sheet 20 to be 8½ inches by 11 inches (Column 2, Lines 59-60). Therefore it would have been obvious to one having ordinary skill in the art to incorporate Popat's sheet size as the sheet size for McKillip's first section of substrate 12 in order to increase the ease of use since the average

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home and office printer has a standard sheet size of 8½ inches by 11 inches and many times forms are printed on 8½ inch by 11 inch sheets. This alteration also increases the consumer market as well.

8. Claims 17 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. 6,989,183) in view of Kelly (U.S. 5,900,610) and in further view of Popat (U.S. 5,389,414).

In regards to Claim 17, McKillip discloses a substrate 12 with first and second surfaces, as seen in Figure 1, with first and second sections that are divided by a line of weakness 20 (Column 5, Lines 25 – 28; Figure 1, Item 20; Column 5, Lines 6 – 10; Figures 1 and 3, Item 12). McKillip further discloses that the second section has a pattern of adhesive 18 along with a release liner 14 covering the pattern of adhesive (Column 5, Lines 11 – 13, Figure 13, Items 14 and 18).

McKillip does not disclose that the first section has a plurality of substantially quadrate sections formed from a series of die cuts. Also not disclosed is the second section having an outer quadrate die cut along with an inner quadrate die cut extending only through the substrate to form a removable label and a perimeter of adhesive for the release liner to be affixed to a carton.

Kelly discloses a label with an outer quadrate die cut 58 and another quadrate die cut 60 inward of the previously mentioned die cut (Column 8, Lines 12 – 16; Figures 6 and 7, Items 58, and 60). Kelly also mentions that cut 58 is only done through the backing layer which is a release material and die cut 60 is only through the substrate (Column 8, Lines 45 – 52, Figure 7, Items 58 and 60).

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When Kelly's die cuts are incorporated to McKillip's release layer 14 the claimed invention is produced. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Kelly's die cuts into the second section of McKillip in order to create a business form with multiple removable labels.

McKillip modified by Kelly does not disclose the first section of substrate 12 having a plurality of substantially quadrate sections formed from a series of die cuts.

Popat teaches a vertical running perforated line 30 (Column 4, Lines 26 – 29; Figure 2) that perpendicularly intersects two perforated lines 32 and 42 (Column 3, Lines 25 – 33, Figure 2, Items 30, 32, 42). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Popat's vertically running perforated line 30 and horizontal line 32 to McKillip's line of weakness 20, where line 32 intersects McKillip's line 20 perpendicularly creating four equal compartments to enabling different types of indicia to be printed. This also allows for a way to reduce size of the sheet by folding it neatly and not damaging any printed indicia.

Popat does not disclose that the quadrate sections are created with die cuts. Applicant discloses that the lines of weakness creating the sections will be used for folding or removing one section from another but the applicant also discloses that the lines are typically perforations and can also be laser scores or any other cut that goes through the first section. This would include die cuts and therefore the use die cuts instead of perforations to create the compartments is

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rejected as substituting equivalents known for the same purpose. In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

In regards to Claim 18, as applied to Claim 17, the first section of substrate 12 is considered to be a full sized sheet as shown in Figure 1 above line of weakness 20.

In regards to Claim 19, as applied to Claim 17, McKillip and Kelly do not disclose a sheet size of 8½ inches by 11 inches.

Popat discloses a sheet 20 to be 8½ inches by 11 inches (Column 2, Lines 59-60). Therefore it would have been obvious to one having ordinary skill in the art to incorporate Popat's sheet size as the sheet size for McKillip's first section of substrate 12 in order to increase the ease of use since the average home and office printer has a standard sheet size of 8½ inches by 11 inches and many times forms are printed on 8½ inch by 11 inch sheets. This alteration also increases the consumer market as well.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. 6,989,183) in view of Kelly (U.S. 5,900,610).

McKillip discloses a substrate 12 with first and second faces that are able to receive indicia and first and second sections that are separated by a line of weakness 20 (Column 5, Lines 25 – 28; Figure 1, Item 20; Column 5, Lines 6 – 10; Figures 1 and 3, Item 12). McKillip also discloses a pattern of adhesive 18 in one of the sections as well as a liner material 14 applied to the same section as the adhesive (Column 5, Lines 11 – 13, Figure 13, Items 14 and 18).

McKillip does not disclose first and second substantially quadrate die cuts, one inward of the other, with the first in the pattern of adhesive and the second inward of the first and in the liner material to form a containment envelope with a perimeter of adhesive.

Kelly discloses a label with an outer quadrate die cut 58 and another quadrate die cut 60 inward of the previously mentioned die cut (Column 8, Lines 12 – 16; Figures 6 and 7, Items 58, and 60). Kelly also mentions that cut 58 is only done through the backing layer which is a release material and die cut 60 is only through the substrate. (Column 8, Lines 45 – 52, Figure 7, Items 58 and 60). When incorporated to McKillip's release liner 14 the claimed invention is produced since the label is being peeled in a different manner. Also once the label is gone and the liner is peeled away from the substrate there will be a perimeter of adhesive since the outer quadrate die cut holds a quadrate portion of the liner to the substrate. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Kelly's die cuts into the release liner of the second section of McKillip in order to create a business form with multiple removable labels.

In regards to one of the first and second sections having the dimensions of a full sized sheet, the first section of substrate 12 in McKillip is considered to be a full sized sheet, as shown in Figure 1, above line of weakness 20.

The component having an edge does not further structurally limit the claim and has not been used to determine patentability.

Allowable Subject Matter

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pradeep Battula
Patent Examiner
July 14, 2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER